

REMARKS

(A) STATUS OF THE APPLICATION

Applicants thank the Examiner for her explanation of the rejections in the Final Office Action dated May 30, 2007.

(I) DISPOSITION OF CLAIMS

- (i) Claims 1-6, 8-10, 12, and 13 are pending in the application.
- (ii) Claims 7, 11, and 14-41 have been previously canceled.
- (iii) Claims 1-3, 5-6, 8-10, and 13 are rejected under 35 U.S.C. § 102(b).
- (iv) Claims 4 and 12 are rejected under 35 U.S.C. § 103(a).

(II) APPLICANTS' ACTION

- (i) For the purpose of clarity, Applicants have amended Claim 1 to remove redundant language relating to Markush group, in light of a previous amendment. As a result of said amendment, only one member is now retained in said group. No new matter was added.
- (ii) Applicants respond to the above rejections.

In the ensuing discussion, comments under the sub-heading "Examiner's Comments" are attributed to the Examiner. Unless specified, Applicants do not generally agree with the assertions made by the Examiner under that sub-heading. Applicants give their views in the comments under the sub-heading "Applicants' Response."

(B) RESPONSE TO REJECTION UNDER 35 U.S.C. § 102(B) UNDER U.S. PATENT NO. 4,315,790 TO RATTEE, ET AL.—CLAIMS 1-3, 5-6, 8-10, & 13

(I) EXAMINER'S COMMENTS

Claims 1-3, 5-6, 8-10, and 13 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,315,790 to Rattee, *et al.* (*hereinafter* "Rattee").

Rattee teaches applying a composition to a fabric or any flexible substrate. The composition includes polymers such as acrylics. A layer of transferable composition

on a supporting flexible substrate such as paper, metal foil, or a plastic film is pressed on the fabric with heating. The layer is subsequently cured. The fabric or other flexible substrate could be part of an automotive body, such as car seat or "other flexible parts."

Therefore, Claim 1 is anticipated. Also, Rattee discloses such other limitations that anticipate Claims 2-3, 5-6, 8-10, and 13.

(II) APPLICANTS' RESPONSE

Applicants respectfully disagree with the Examiner because:

- (i) the general definition of the term "automotive body" does not include fabrics or flexible car seats, and
- (ii) in the alternative, even if the definition of the term "automotive body" were to include fabrics and flexible car seats, or vice versa, a genus does not always anticipate a species.

(i) Why "Automotive Body" Does NOT Include Rattee Type of Fabric or Flexible Substrate

Applicants respectfully submit that the term "Automotive Body," as mentioned in the Specification of the present patent application, or as understood by a person skilled in the art, does not include Rattee type of fabric or flexible substrates.

(a) Specification

Applicants cite below several instances from the Specification that demonstrate that by "automotive body," Applicants must not have meant the Rattee type of fabric or flexible substrate, the center-point of Rattee.¹

1. The Title and the Abstract relate to a paint coating layers with applications in automotives. This cannot mean painting Rattee type of fabric or flexible substrate.²
2. Paragraph 0019 includes objects made from metals, plastics, fiber-reinforced plastics, or wood. Clearly, the Specification does not envision Rattee type of textile fabric or flexible substrate.

¹ Citations from Published Application No. US 2004/0076756 A1.

² *Id.* at "Title" and Para. 0002.

3. Paragraph 0020 discusses electrodepositing a primer on a substrate known from the automotive coating sector. Clearly, in automotive coating sector, one skilled in the art does not coat Rattee type of textile fabric or flexible substrate.
4. Paragraph 0048 refers to applying backing foils to 3-dimensional substrates that have cavities and undercuts, such as automotive bodies where it is not possible to provide coating on entire surface. This indicates that the substrate is not flexible, i.e., not a Rattee type of textile fabric or flexible substrate.
5. Paragraphs 0056-0060 indicate that the coating provides protection against acid resistance, chemical resistance, scratch resistance, low soiling tendency such as anti-graffiti properties, and self-cleaning effect from rain. Clearly, a person skilled in the art will not understand the paragraph to mean a Rattee type of textile fabric or flexible substrate. Such person is likely to derive the meaning of automotive body to include, *inter alia*, outside body of an automotive.
6. Paragraph 0061 mentions Lotus Effect® for self-cleaning surface textures. The Lotus Effect® relates to highly-water repellant exterior surfaces. It does not relate to flexible textile fabrics such as that in Rattee.
7. Paragraph 0062 relates to a "sealing coat layer, in this case for scratch protection purposes, . . . onto areas of the body that are exposed to a particular risk of scratching in service. Examples of areas of a motor vehicle which are at particular risk of scratching in service are the areas around the locks or door handles together with loading areas or door openings, in particular for example where sills jut out beneath door openings, which are at particular risk of scratching when occupants get into or out of the vehicle. Further examples of areas of an automotive body that are at risk of scratching are areas which are suitable for accommodating external loads, for example, the roof or hatchback." (Emphasis added). Thus, it is clear that Applicants must not have meant the Rattee type of textile fabric or flexible substrate when describing the coating relating to automotive body.
8. Paragraph 0088 describes an example wherein a metal panel is coated with a typical automotive multi-layer coating comprising an electrodeposited primer, surface coat, base coat and clear coat.
9. In original Claim 11, the substrate was selected from automotive body, body parts, and body fittings. Applicants submit that Applicants must have meant that automotive body and body parts were different entities. In previous Office Actions, when the Examiner raised the issue of said [automotive] body part comprising Rattee type of textile fabric or flexible substrate,

Applicants responded by deleting “[automotive] body parts” from the claims.³ Only in the subsequent Office Action (i.e., the present one) did the Examiner suggest that even “automotive body” can include Rattee type of textile fabric or flexible substrate. The Examiner did not raise the issue of “automotive body” comprising Rattee type of textile fabric or flexible substrate, in said previous Office Action. Applicants consequently infer that at the time of the previous Office Action, the Examiner considered “automotive body” and “[automotive] body parts” as separate entities, with “[automotive] body parts” implicating Rattee type of textile fabric or flexible substrate. Only after reconsidering Applicants’ application in light of Rattee and prior to the present Office Action, did the Examiner suggest that “automotive body” should also include Rattee type of textile fabric or flexible substrate. Clearly, this inference is hindsight reconstruction based on the Applicants patent application.

(b) Understanding of “Automotive Body” by a Person of Ordinary Skill in Art

Applicants enclose three articles that provide an understanding of the term “body” as it relates to an automobile.

Article I from Encyclopedia Britannica states that:

The body of an automobile encloses or partly **encloses the vehicle's mechanical parts and the driver and passengers**. The term body **does not include** the car's motor, transmission, chassis, or frame. Sometimes, however, the body is integrated with the frame as a solid unit. The body of a truck includes the structure that carries the cargo.⁴(Emphasis added).

Article II from Encyclopedia Britannica states that:

The body of an automobile **is the outer shell that encloses the vehicle's mechanical parts and its passengers**. Most auto bodies are made of steel.⁵

Article III from Encyclopedia Britannica states that:

Automotive body designs are frequently **categorized according to the number of doors, the arrangement of seats, and the roof structure**. Automobile roofs are conventionally supported by pillars on each side of the body. . .

Automotive bodies are generally formed out of sheet steel. The steel is alloyed with various elements to improve its ability to be formed into deeper depressions without wrinkling or tearing in manufacturing presses. Steel is used because of its general availability, low cost, and good workability. For certain applications, however,

³ Applicants note that an amendment to the claims, wherein Applicants deleted “body parts” from the Markush group, in response to the rejection in the previous Office Action based on Rattee must not be construed as an admission by the Applicants that automotive “body parts” include, or are included by, the scope of the Rattee disclosure. Applicants made said amendment in order to expedite prosecution, as pointed out previously, and elsewhere.

⁴ See enclosed Article I, cited as Britannica Student Encyclopedia. 2007. Encyclopaedia Britannica Online. 14 Aug. 2007 <<http://www.britannica.com/ebi/article-197009>>.

⁵ See enclosed Article I, cited as Britannica Elementary Encyclopedia. 2007. Encyclopaedia Britannica Online School Edition. 14 2007 <<http://school.eb.com/ebk/article?articleId=352807>>.

other materials, such as aluminum, fibreglass, and carbon-fibre reinforced plastic, are used because of their special properties. Polyamide, polyester, polystyrene, polypropylene, and ethylene plastics have been formulated for greater toughness, dent resistance, and resistance to brittle deformation. These materials are used for body panels. . .

To protect bodies from corrosive elements and to maintain their strength and appearance, special priming and painting processes are used. Bodies are first dipped in cleaning baths to remove oil and other foreign matter. They then go through a succession of dip and spray cycles. . . Galvanized steel with a protective zinc coating and corrosion-resistant stainless steel are used in body areas that are more likely to corrode.⁶

The above examples show the skilled artisan's likely understanding the term "automotive body." While Applicants, by way of above examples, do not suggest the boundaries of the scope of "automotive body" as used in the claims of the present patent application, it is clear that the term "automotive body," as understood by a person of ordinary skill in the art does not include the Rattee type of textile fabric or flexible substrates. To equate the Rattee type of textile fabric or flexible substrate with automotive body is contravention of the understanding held by a person of ordinary skill in the art.

Thus, neither the Specification nor the understanding of a person skilled in the art suggest that Rattee type of flexible textile fabrics and substrates include automotive body or vice versa.

(ii) Alternative Argument- A Genus Does Not Always Anticipate a Species

Consistent with the Applicants' discussion *supra*, Applicants reiterate that the term "Automotive Body," as used in the Specification of the present invention, or *otherwise*, does NOT include Rattee type of textile fabric or flexible substrate. However, assuming a hypothetical scenario in which such items were included within the scope of the term "Automotive Body," Applicants initiate the ensuing discussion.

According to the MPEP § 2131.02(A) "[a] genus does not always anticipate a claim to a species within the genus." However, a "disclosure of a small genus may anticipate the species of that genus even if the species are not themselves recited."⁷

⁶ See enclosed Article III, cited as Encyclopaedia Britannica Online. 14 2007 <<http://www.search.eb.com/eb/article-259041>>.

⁷ *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1380 (Fed. Cir. 2001); the Bristol-Myers Squibb Test and its exceptions.

Also, "when the species is clearly named, the species claim is anticipated no matter how many other species are additionally named."⁸ But the present invention suffers from neither of the two enumerated infirmities, as discussed below.

The genus disclosed in Rattee is exceptionally broad, covering "any flexible substrate which needs to be decorated like a textile" (*hereinafter* the "Rattee genus").⁹ With such a statement, a person skilled in the art could envision that the Rattee genus includes a flexible substrate that is *anything* that is not rigid. Clearly, it is not a small genus (and "automotive body" is not recited in Rattee, even if it was an accepted fact-and it is not- that "automotive body" was a sub-genus/species of the Rattee genus). Therefore, the first exception of the BMS test does not aid Rattee's anticipation of the present invention under 35 U.S.C. § 102(b).

Secondly, "automotive body," even if it were an acknowledged and a known member of the Rattee genus, is not recited in Rattee, at all. In fact, Rattee does not name any "species" related to automobiles,¹⁰ while naming "textile fabrics" as a preferred subgenus.¹¹ Applicants' substrates, on the other hand, are restricted to automotive body, a far narrower group than what is disclosed in Rattee (Applicants reiterate that "automotive body" is not EVEN a part of the textile fabric subgenus; the argument is made with a hypothetical assumption that EVEN IF "automotive bodies" were to be a subgenus/species of the Rattee genus. . .). In fact, in the previous Office Action Response, for this very reason, Applicants amended Claim 1 to include ONLY "automotive bodies" as the substrate and deleted the reference to "[automotive] body parts."¹² Thus, even the second exception to the BMS test fails to aid Rattee's anticipation of the present invention under 35 U.S.C. § 102(b).

⁸ See MPEP § 2131.02(A).

⁹ See Rattee, Col. 1, Lines 10-11.

¹⁰ The only species that appear to be named in Rattee are types of fabrics found in the examples, such as a knitted cotton T-shirt, mercerized cotton, cotton/polynosic rayon blend, woven cotton, and knitted polynosic rayon.

¹¹ See Col. 1, Lines 4-6.

¹² For record, Applicants do not agree that even automotive body parts are a subset of, or have a set of items that can be a subset of, the Rattee genus. However, said amendment in the previous Office Action Response was made under the belief that it would expedite prosecution, as was expressly stated in said Response.

Applicants respectfully submit that Rattee fails to anticipate Claim 1 of the invention. As such, the dependent claims thereto should also be novel.

(C) RESPONSE TO REJECTION UNDER 35 U.S.C. 103(A) U.S. PATENT No. 4,315,790 TO RATTEE, ET AL.—CLAIMS 4 & 12

(I) EXAMINER'S COMMENTS

Claims 4 and 12 are rejected under 35 U.S.C. § 103(a) as being obvious over Rattee.

The Examiner has applied arguments from the previous section for establishing *prima facie* obviousness of Claims 4 and 12. The Examiner also suggests that although Rattee does not teach a textured supporting substrate, it is an obvious variant of its process (for Claim 4). Secondly, although Rattee does not teach transparent compositions, Example 12 of Rattee, containing no pigment, would be transparent.

(II) APPLICANTS' RESPONSE

Applicants respectfully traverse these rejections.

According to the MPEP § 2143.01(I), to establish a *prima facie* case of obviousness, *inter alia*, there must be some suggestion in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference to produce Applicants' claimed invention. A broad disclosure of the decoration of "any flexible substrate which needs to be decorated like a textile" is *not* a suggestion to coat the automotive body, as claimed by Applicants. "The fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness."¹³ Nothing in the remainder of Rattee provides such a suggestion, either.

¹³ See generally MPEP § 2144.08(II).

Secondly, Applicants disagree that Rattee's Example 12 contains no pigment. In fact, said example does use 20% of copper phthalocyanine, a blue dye.¹⁴

Because a *prima facie* case of obviousness cannot be established against Claim 1, Applicants respectfully submit that dependent Claims 4 and 12 cannot be obvious over Rattee.

¹⁴ See Rattee, Col. 12, Lines 20-21, and Lines 31-33.

CONCLUSION

In view of the above remarks, Applicants respectfully submit that the stated grounds of rejection have been properly traversed, accommodated, or rendered moot and that a complete response has been made to the Final Office Action mailed on May 30, 2007.

Therefore, Applicants believe that the application stands in condition for allowance with withdrawal of all grounds of rejection. A Notice of Allowance is respectfully solicited.

If the Examiner has questions regarding the application or the contents of this response, the Examiner is invited to contact the undersigned at the number provided.

Should there be a fee due which is not accounted for, please charge such fee to Deposit Account No. 04-1928.

RESPECTFULLY SUBMITTED,

DATE: AUGUST 20, 2007

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